



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of

HAMER et al.

Atty. Ref.: 124-1105; Confirmation No. 8690

Appl. No. 10/524,492

TC/A.U. 2623

Filed: February 14, 2005

Examiner: A. Bhatnagar

For: HISTOLOGICAL ASSESSMENT

\* \* \* \* \*

March 27, 2006

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**RESPONSE**

This is responsive to the Official Action mailed December 27, 2005 (Paper No. 20051221), the date of response to which is March 27, 2006.

Claims 57-87 stand variously rejected in the outstanding Official Action. Claims 57-87 remain in this application.

The Examiner's acknowledgment of Applicants' claim for priority and receipt of the certified copies of the priority document is very much appreciated. Additionally, the Examiner's consideration of Applicants' previously submitted Information Disclosure Statements and the references included therein is appreciated.

The Examiner, between pages 2 and 4, cites numerous provisional rejections of the claims in this application under the provisions of 35 USC §101 over the invention claimed in co-

pending Application 10/274,358. The two applications and the following comments were contained in a telephone discussion with Examiner Bhatnagar conducted on or about January 4, 2006.

Examiner Bhatnagar was informed that the co-pending Application No. 10/274,358, when filed, erroneously omitted co-inventor Margaret J. Varga. Because the original application was a regular U.S. filing claiming priority from a number of GB applications, Applicants' course of action would have been to correct the inventive entity by adding the inadvertently omitted inventor. However, Applicants also filed a PCT International application naming the United States and naming the proper inventive entity, i.e., including Ms. Varga.

After a brief review of the PCT application and noting that the claims were identical, it was decided that a simpler response would be the filing of a national phase §371 application based upon the PCT International application (which included the omitted inventor Varga). This national phase entry resulted in the above-identified application, i.e., Serial No. 10/524,492. Once it was confirmed that the Patent Office had considered the present application, confirmed the §371 national phase entry status of the application and confirmed the priority through the PCT application back to the four cited UK patent applications, the earlier filed co-pending Application No. 10/274,358 would be abandoned.

The correct filing information with respect to this application has been confirmed in both the filing receipt and in the information contained in the outstanding Official Action. As indicated to Examiner Bhatnagar, Applicants proposed the abandonment of the co-pending Application No. 10/274,358 and the Examiner agreed that such abandonment would avoid all double patenting rejections set out in the present application. The Examiner also agreed that

because the inventors of the previous application and the inventors of the present application were all subject to an obligation to assign to the assignee, QinetiQ Limited, the abandonment of the previous application would obviate any further double patenting objections and rejections. Also, because both applications claim priority from the same four British patent applications, the previous application could not be a reference under §102 against the present application, again especially in view of the obligation to assign to the common assignee, QinetiQ Limited.

In view of the agreement reached with Examiner Bhatnagar, Applicants enclose a copy of a letter of express abandonment in co-pending Application No. 10/274,358 abandoning that application in favor of the present application Serial No. 10/524,492. This letter of abandonment has been filed concurrently with this response and therefore as of this date, the co-pending application has been abandoned. Inasmuch as the co-pending Application No. 10/274,358 has been abandoned, this abandonment obviates all of the provisional double patenting rejections set out on pages 2-4 of the outstanding Official Action.

Additionally, the abandonment of co-pending Application No. 10/274,358 obviates any basis for rejection under 35 USC §102(e) inasmuch as both applications claim priority from the same four British patent applications and therefore neither application invention date is "before" the other (It is noted that the United Kingdom is a WTO country). Thus, relying upon the evidence of record, the co-pending application Serial No. 10/274,358 is not available as prior art against the presently pending application.

Having responded to all objections and rejections set out in the outstanding Official Action, it is submitted that claims 57-87 are in condition for allowance and notice to that effect is respectfully solicited. In the event the Examiner is of the opinion that a brief telephone or

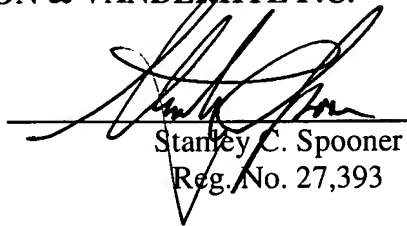
HAMER et al.  
Appl. No. 10/524,492  
March 27, 2006

personal interview will facilitate allowance of one or more of the above claims, he is respectfully requested to contact Applicants' undersigned representative.

Respectfully submitted,

**NIXON & VANDERHYTE P.C.**

By: \_\_\_\_\_



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